

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-4 and 6-8 are presently pending in this application, Claim 5 was canceled previously without prejudice or disclaimer, and Claim 1 has been presently amended.

In the outstanding Office Action, Claims 1-4 and 6-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takemiya et al. (U.S. Patent 6,372,351).

Regarding the art rejection, in comparing amended Claim 1 with Takemiya et al. Claim 1 defines an epoxy resin composition in which a carbon precursor has a specific electric resistance value of $1 \times 10^4 \Omega \cdot \text{cm}$ to $1 \times 10^6 \Omega \cdot \text{cm}$, whereas Takemiya et al. describes a carbon precursor with a specific electric resistance value of $1 \times 10^7 \Omega \cdot \text{cm}$ or above, and more preferably $1 \times 10^9 \Omega \cdot \text{cm}$ (see column 8, lines 41-44 or Claim 2 of Takemiya et al.). Thus, Takemiya et al. do not anticipate and even teach away from the claimed range of resistivity.

In Claim 1, the epoxy resin composition for semiconductor sealing containing the carbon precursor having an electric specific resistance value of $1 \times 10^4 \Omega \cdot \text{cm}$ to $1 \times 10^6 \Omega \cdot \text{cm}$ can avoid occurrence of a short circuit and leak current due to conductive particles stuck in the spaces between wires of semiconductor devices, which are increasingly finely pitched in recent years (See Applicant's Examples 1 to 7). On the other hand, the epoxy resin composition for semiconductor sealing of Takemiya et al., in which a carbon precursor with an electric specific resistance value of $1 \times 10^7 \Omega \cdot \text{cm}$ or more is used, is liable to have aggregate particles of the carbon precursor stuck between wires, and can easily cause short-circuit of wiring, leakage defects, and the like. (See Applicant's Comparative Example 5 n

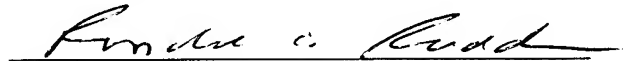
which carbon precursor of $1 \times 10^9 \Omega \cdot \text{cm}$ is used and See Applicant's Comparative Example 6 in which carbon precursor of $1 \times 10^{10} \Omega \cdot \text{cm}$ is used.)

With the defined electrical resistivity and the advantages thereof not being disclosed or suggested in Takemiya et al, Claim 1 and the claims dependent therefrom are believed to patentably define over Takemiya et al.

In view of the amendments and discussions presented above, Applicant respectfully submits that the present application is in condition for allowance, and an early action favorable to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Akihiro Yamazaki
Attorney of Record
Registration No. 46,155

Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413 -2220
(OSMMN 06/04)

Ronald A. Rudder, Ph. D.
Registration No. 45,618

AY/RAR/

I:\ATTY\AKY\25S\251428\251428US_AME 2.DOC